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2645

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Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 09/314,966 | Applicant(s) ALI ET AL. | |
| | Examiner Simon Sing | Art Unit 2645 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-7, 9-15 and 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Friedman et al. US 4,122,306.

1.1 Regarding claim 1, Friedman discloses a telephone answering apparatus in figure 1 (column 5, lines 20-54). The apparatus comprises:

a line interface 28;

a dialing decoder (controller) 48 for determining which track of a 8-track for playing an outgoing message and recording an incoming message based on a code (column 6, lines 58-67; column 7, lines 1-24);

an 8-track tape player/recorder 32 and a cassette recorder 38 (voice message memory) adapted to store voice messages; and

a secured message authorization module (dialing decoder 48) adapted to allow a party (owner) calling said telephone answering apparatus to leave a voice message, together with a security code (such as 76) corresponding a pre-authorized caller (with assigned code number 76), to secure a voice message in the 8-track tape for said pre-

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authorized caller (column 7, lines 35-46; column 8, lines 32-57), and said pre-authorized caller may also secure a voice message in said telephone answering apparatus for another caller (each voice message left in said telephone answering apparatus is secured since a caller is required to input a code pre-assigned to him/her) (column 7, lines 64-68; column 8, lines 1-20).

1.2 Regarding claim 2, Friedman teaches an 8-track tape recorder for recording a voice message from a caller (column 7, line 64 to column 8, line 20).

1.3 Regarding claim 3, Friedman teaches a security code table for comparing a security code entered (column 18, lines 53-68; column 19, lines 22-33).

1.4 Regarding claims 4-5, Friedman teaches that the security code table includes security codes (call related information) (column 19, lines 22-33).

1.5 Regarding claim 6, Friedman teaches assigning security codes to callers corresponding to each track of the 8-track tape (column 6, line 58 to column 7, line 2).

1.6 Regarding claims 7 and 10, Friedman teaches a dialing decoder 48 for matching the security code (call related information) (column 7, lines 13-18; column 19, lines 22-33).

1.7 Regarding claim 9, Friedman teaches a dialing decoder 48 for detecting, receiving and decoding the security code (call related information) (column 18, lines 53-68; column 19, lines 22-33).

1.8 Regarding claim 11, Friedman discloses a method for securing a voice message in an 8-track tape player/recorder 32 (single mailbox) in a telephone answering apparatus, comprising steps of:

prompting a party (owner) calling said telephone answering apparatus to leave a voice message to enter an authorized security code (such as 76) corresponding to at least one pre-authorized caller (caller with pre-assigned code 76) to said telephone answering apparatus (column 7, lines 35-46; column 8, lines 32-57) who (said pre-authorized caller) may also secure a voice message for another caller (column 7, lines 64-68; column 8, lines 1-20);

comparing said security code to a pre-stored security code (column 7, lines 8-18, 44-46; column 19, lines 22-33);

upon matching said security code, securing said voice message for access by said pre-authorized caller (column 7, lines 35-46; column 8, lines 32-57; column 7, lines 3-23).

1.9 Regarding claims 12-14, Friedman teaches securing said voice message at a pre-assigned track of the 8-track tape player/recorder 32 (column 7, lines 53-60).

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1.10 Regarding claim 15, Friedman teaches entering said security code from a telephone keypad by the party calling the telephone answering apparatus (column 7, lines 44-46).

1.11 Regarding claim 18, Friedman discloses a telephone answering apparatus for securing a voice message in an 8-track tape player/recorder 32 (single mailbox), comprising:

means prompting a party (owner) calling said telephone answering apparatus to leave a voice message to enter an authorized security code (such as 76) corresponding to at least one pre-authorized caller (caller with pre-assigned code 76) to said telephone answering apparatus (column 7, lines 35-46; column 8, lines 32-57) who (said pre-authorized caller) may also secure a voice message for another caller (column 7, lines 64-68; column 8, lines 1-20);

means comparing said security code to a pre-stored security code (column 7, lines 8-18, 44-46; column 19, lines 22-33);

means for securing said voice message for access by said pre-authorized caller to playback upon matching said security code, (column 7, lines 35-46; column 8, lines 32-57; column 7, lines 3-23).

1.12 Regarding claim 19-21, Friedman teaches securing (recording) said voice message at a pre-assign track of the 8-track tape player/recorder 32 (column 7, lines 53-60).

1.13 Regarding claim 22, Friedman teaches entering said security code from a telephone keypad by the party calling the telephone answering apparatus (column 7, lines 44-46).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1-7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nabkel US 5,963,626.

2.1 Regarding claim 1, Nabkel discloses a voice messaging system in figure 6, comprising:

a telephone line interface for accepting telephone calls from callers (column 2, lines 29-33);

a controller for comparing subscriber (caller) IDs and PINs (column 2, lines 30-37; column 4, lines 27-33);

a secured message authorization module (controller plus application software) adapted to allow a party (subscriber) calling said voice messaging system to leave a private voice message, and a security code corresponding to another caller such as Julieann (column 3, lines 16-21, 24-26). Nabkel teaches securing said private voice message in a mailbox with an assigned personal PIN (security code) corresponding to Julieann (column 2, lines 58-65; column 3, lines 53-58), and said private voice message is accessible only by Julieann with said assigned personal PIN (figure 5; column 6, lines 1-23; column 4, lines 37-47) (examiner note: "the subscriber" in line 46, column 6, should be changed to "the calling party").

Nabkel fails to specifically teach that a calling party, such as Julieann, is also a subscriber (a preauthorized caller who may to secure a voice message for other callers).

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Nabkel's system, such that a caller who was a voice message recipient would also have been a subscriber of the voice messaging system, because such modification would have enabled subscribers to leave voice messages for each other.

2.2 Regarding claim 2, Nabkel's system further comprising:

a playback/recording module adapted to record said private voice message (column 3, lines 16-26) or playback said private voice message to a calling party (column 4, lines 41-47).

2.3 Regarding claim 3, Nabkel' system according claim 1, further comprising:

an authorized security code table including information relating to an ability of a party (subscriber) calling said voice messaging system to separately secure said private voice message (column 2, lines 29-33, 58-65; column 3, lines 53-58).

2.4 Regarding claim 4, Nabkel's system according to claim 3, wherein:

said authorized security code table further includes at least one security code (personal PIN) allowing at least one calling party (i.e. Julieann) for access to said separately secured private voice message (column 2, lines 58-65; column 3, lines 53-58; column 4, lines 41-47).

2.5 Regarding claim 5, Nabkel's system according to claim 3, wherein:

said authorized security code table is adapted to includes call related information (personal PIN) relating to at least one calling party (who is also a subscriber) authorized to secure a voice message (column 2, lines 29-33, 58-65).

2.6 Regarding claim 6, Nabkel's system according claim 1, wherein:

Nabkel teaches entering a personal PIN associated with a calling party (column 3, lines 53-58).

2.7 Regarding claim 7, Nabkel's system according claim 1, wherein:

said secured message authorized module is adapted to allow a party (subscriber) calling the voice messaging system to secure a voice message upon matching call related information (PIN) relating to the party with a pre-stored PIN (column 2, lines 29-33).

2.8 Regarding claim 9, Nabkel's system according claim 1, further comprising:

a call related information detector/receiver adapted to detect and receive call related information (PIN) regarding a party (subscriber) calling said voice messaging system (column 2, lines 29-33; column 6, lines 10-23).

2.9 Regarding claim 10, Nabkel's system according claim 1, wherein:

said controller is adapted to compare call related information received regarding a party (subscriber) calling the voice messaging system, with at least one pre-stored authorized security code to allow said party to separately secure a voice message (column 2, lines 29-33, 58-65; column 3, lines 53-58).

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nabkel US 5,963,626 in view of Carleton et al. US 5,966,351.

Nabkel teaches a voice messaging system in that a party (subscriber) leaves a private voice message in a single mailbox, and secures said private voice message with

a personal PIN associated with another caller (message recipient). Nakel fails to specifically teach that said personal PIN is attached to private voice message's header.

However, Carleton discloses a voicemail system in that a voice message's header comprises sender's telephone number (extension), date and time, status and any special handling code. When a sender accesses a recipient's mailbox, sender's telephone number is compared to the telephone number stored in the header, and the sender is only allowed to access messages with same telephone number (column 4, lines 40-56).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Nabkel's reference with the teaching of Carleton so that said personal PIN would have been attached to the header of said private voice message, because such modification would have clarified the teaching of Nabkel to where said personal PIN was stored with said private voice message.

Response to Arguments

4. Applicant's arguments filed on 11/04/2004 have been fully considered but they are not persuasive.

4.1 Rejection over Friedman:

Applicants argue in the Remark that Friedman assigns a number (security code) corresponds to a pre-selected track of an 8-track tape, not to a pre-authorized caller to

the telephone answering device who may secure a voice message (page 7, paragraph 4 of the Remark), and Friedman only teaches a limited number of callers due to limited track number on the tape (page 8, first paragraph of the Remark)

However, Friedman teaches pre-assigning a particular number (code) to a particular caller, and said particular number authorizes said particular caller to access said telephone answering device (column 7, lines 3-18). As examples, Friedman teaches assigning number (security code) 76 associated with track 4 to a first caller, and number 24 associated with track 3 to a second caller. Friedman's telephone answering device is able to assign up to eight numbers (codes) to eight callers (column 8, lines 53-57). Since these numbers are random and do not correlate with track numbers, callers without a pre-assigned number, or code, are unable to access the telephone answering device, thus, every voice message stored in the telephone answering device is secured. As discussed in the Office Action, the owner of the telephone answering device calls the answering device from a remote telephone, and leaves a voice message for the first caller (who is a pre-authorized caller with assigned code 76) by entering number 76 on the remote telephone. The first caller is able to leave (secure) a voice message in the telephone answering device for the second caller if the first caller knows the number (security code) of the second caller beforehand, such that the owner leaves a secure voice message with the security code (76) corresponding to the first caller who is authorized to secure another voice message for a second caller. As mentioned earlier, Friedman teaches assigning up to eight numbers (security code) to eight callers, and the current invention only claims at least one pre-

authorized caller, therefore, Friedman teaches all claimed limitation in claims 1, 11, and 18.

4.2 Rejection over Nabkel:

Nabkel teaches a messaging system in that a subscriber (first caller) leaves a voice message to a second caller with a personal PIN corresponding to the second caller to secure said voice message, such that only the second caller with said personal PIN is able to access said voice message. Since the second caller is able to access said messaging system, the second caller is a pre-authorized caller. It is obvious if not inherent (Applicants acknowledged that it is inherent, see page 9, paragraph 4 of the Remark) that the second caller can also be a subscriber who may secure a voice message for other callers. Nabkel thus teaches a first caller calling the messaging system to leave a secure voice message with a security code (personal PIN) corresponding to the second caller who is a pre-authorized caller to the messaging system and who may secure voice messages for other callers.

Applicants argue that Nabkel fails to teach an authorization module adapted to allow a party calling the messaging system to leave a voice message together with a security code corresponding to at least one pre-authorized caller to the messaging system who may secure a voice message. However, since Nabkel teaches allowing a first caller calling the messaging system to leave a voice message with a security code (personal PIN) corresponding to the second caller who is a pre-authorized caller to the messaging system and who may secure voice messages for other callers, then

Nabkel's messaging system must have means (authorization module) for performing above task. Therefore, Nabkel teaches the claimed limitation of current invention as recited in claim 1.

4.3 Rejection over Nakel in view of Carlton:

Since the Applicants' argument is the same as above (Nabkel), there is no additional response. Please refer to the section 4.2


Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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6. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.



S.S.

03/18/2005



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